



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

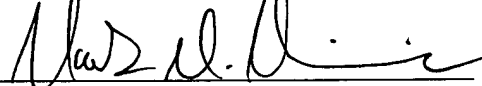
First Named Inventor: Levitan
Application Number: 09/544,799
Filing Date: April 7, 2000
Title: Magnetically Actuated
Microelectromechanical Systems Actuator

Date of Amendment: August 17, 2001

Examiner: Shafer, R.
Art Unit: 2872

Certificate of Mailing Under 37 C.F.R. § 1.8

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on August 17, 2001 as first class mail in an envelope addressed to The Assistant Commissioner For Patents, Washington, D.C. 20231.


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RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Applicants respond as follows to the Patent and Trademark Office action dated July 12, 2001.

Applicants elect the claims of Group I, together with claims 1 and 5, subject to the following traversal.

The Examiner states that the inventions of claim Groups I, II, III, and IV are related as combination and subcombination. The Examiner states that "the combination as claimed does not require the particulars of the subcombination" and that the "subcombination has utility by itself." Applicant submits that this restriction requirement is improper and should be withdrawn for the following reasons.

Applicants cannot discern from the office action which claim or Group is the purported combination and which are the purported subcombinations. Accordingly, applicants submit that the restriction requirement is improper and should be withdrawn because the restriction requirement is incomplete and has inadequate explanation and support.

Applicants submit that the restriction requirement is based upon an improper characterization of combination/subcombination claim relationships to

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which restriction is applicable. The combination/subcombination relationship relates to claims as a whole, such as a claim AB_{br} and a separate claim B_{sp}, as illustrated at MPEP 806.05(c)(I). All the claims in Groups I, II, and III, depend from independent claim 1. In the notation of the MPEP, the claims in Groups I, II, and III may be represented as AB, (AC)D, and (AC)E, respectively, where A represents claim 1, C represents claim 5, and B, D, and E represent the subject matter of respective Groups I, II, and III. None of the dependent claims of Groups I, II, and III is directed to a stand-alone subcombination claim (e.g., only "B") that is otherwise included in a combination of any other claim.

The restriction requirement appears to be based on an interpretation that the individual claim elements of the dependent claims are "subcombinations" of claim 1. Such an interpretation of dependent claim elements is improper and incorrect. A dependent claim includes all the subject matter of its parent claim. When properly considering each dependent claim in its entirety, none of the claims of Groups I, II, and III is directed to a feature that is in another claim as part of a combination. The restriction requirement relating to Groups I, II, and III should be withdrawn.

Applicants note that claim 5 also depends from claim 1. Claim 5, like the claims of Groups I, II, and III, cannot be and is not a subcombination claim relative to claim 1. In the absence of any restriction requirement being made between claims 1 and 5, and the erroneous basis for the restriction requirement between Groups I, II, and III, applicants submit that claim 5 should not be subject to restriction relative to claim 1.

Moreover, the restriction requirement is incomplete because it provides no characterization or grouping for claims 1 and 5. Applicants have no way of electing either of claims 1 and 5, or knowing the status of those claims based upon the groupings provided by the Examiner. The absence of a restriction requirement as to claims 1 and 5 suggests that they are not distinct from any of the other groups.

Independent claim 11 of Group IV recites a microelectrical mechanical actuator having a planar substrate, first and second coil members, and a magnetic flux means. Claim 5, for which no restriction has been made relative to claim 1, recites a microelectrical mechanical actuator having a planar substrate, first and second coil members, a magnet, and magnetic fluxes. Accordingly, the claims of Group IV are related to claim 5 and are not a subcombination of any "combination claim" in the application. Applicants submit, therefore, the restriction requirement with regard to of Group IV is improper and should be withdrawn.

Independent claim 31 of Group VII recites a microelectrical mechanical actuator having a planar substrate, first magnetic-material member providing a first magnetic flux, and an electromagnet providing a second magnetic flux. Applicants submit that the subject matter of claim 31 and dependent claims 32-38 is analogous to that of unrestricted claim 5. Accordingly, the claims of Group VII are related to claim 5 and are not a subcombination of any "combination claim" in the application. Applicants submit, therefore, the restriction requirement with regard to of Group VII is improper and should be withdrawn.

Applicants submit that the claims of Groups I-IV and VII are directed to a common invention and that restriction between these Groups and claims 1 and 5 is improper and unsupported. The Examiner states that:

"the combination as claimed does not require the particulars of the subcombination as claimed because of the omission of a second conductive coil, as evidenced by claim 2; the omission of the particular coil details, as evidenced by claims 5 and 9; or the omission of the substrate having first and second conductors or a mirror, as evidenced by claim 11."

By these examples, the Examiner merely cites dependent claims that recite additional features with regard to a parent claim. The Examiner never indicates which claim is the combination of which the claims of Groups I-IV and VII are purportedly subcombinations. By the Examiner's rationale, EVERY dependent claim would be a subcombination of its parent because the dependent recites a feature not included in the parent. Such is not the law. In view of the improper

basis of the combination/subcombination restriction requirement and the lack of supporting rationale because no "combination" claim is identified, applicants request that the restriction requirement between the claims of Groups I-IV and VII be withdrawn.

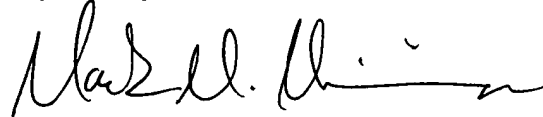
Independent claim 17 of Group V recites a mirror actuator device having a first and a second actuator, a mirror, and a magnetic flux source. Independent claim 24 of Group VI recites a microelectrical mechanical system actuator for moving a mirror having a planar substrate, a plurality of actuators, a magnetic flux source, and a first and a current source. With regard to the restriction requirement between Groups V and VI, applicants submit that the subject matter of independent claim 17, and its dependent claims, is analogous to the subject matter of independent claim 24, and its dependent claims. The claims of Groups V and VI are directed to combinations of actuators, mirrors, and magnetic flux sources. The claims of Groups V and VI are not related to each other or any other claims as combination/subcombination. The Examiner has made no indication what claim recites the combination of which Groups V or VI is purportedly a subcombination. Applicants submit, therefore, the restriction requirement with between Groups V and VI is improper and should be withdrawn.

With regard to the restriction requirement between Groups V and VI, and the other claim Groups, applicants submit that the subject matter of Groups V and VI is analogous to the subject matter of Group III. The claims of Groups V and VI are directed to combinations of actuators, mirrors, and magnetic flux sources, as are the claims of Group III. As indicated above, the claims of Group III are not directed to a stand-alone subcombination claim (e.g., only "B") that is otherwise included in claim 1, or any other claim. Similarly, the claims of Groups V and VI are not directed to a stand-alone subcombination claim (e.g., only "B") that is otherwise included in any other claim. Applicants submit, therefore, the restriction requirement with regard to of Groups V and VI, relative to the other claim Groups, is improper and should be withdrawn.

Applicants believe the application is in condition for consideration
and respectfully request the same.

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Respectfully Submitted,



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[Signature]
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TRANSMITTAL LETTER

Assistant Commissioner for Patents
Washington, D.C. 20231

- Enclosed for filing in the above-identified application is/are:
- Response to the Restriction Requirement Office Action dated July 12, 2001
 - One month extension of time to September 12, 2001 is requested
 - Check for \$110 to cover the extension fee

The fee has been calculated as follows:

Claims as Amended								
For	Number After Amendment		Number Previously Paid For		Present Extra		Rate	Fee
Total Claims	38	-	38	=	0	x	18	0
Independent Claims	5	-	5	=	0	x	80	0
Total Additional Fee For This Amendment								0

Please charge any additional fees that may be required in connection with filing this amendment and any extension of time, or credit any overpayment, to Deposit Account No. 500241. A copy of this sheet is enclosed.

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